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Paper 155 **34**  
Filed: January 9, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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MARK DOUGLAS HOWELL,  
CHERYL LYNN SELINSKY, and LELAND CHARLES LEBER  
Junior Party  
(Patent 6,379,708),

v.

M. RIGDON LENTZ  
Senior Party  
(Application 09/709,045).

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Patent Interference No. 105,413  
(Technology Center 1600)

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Before Torczon, Lane, and Tierney, Administrative Patent Judges.

Lane, Administrative Patent Judge.

**Decision – Priority – Bd.R. 125(a)**

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Howell and Lentz each moved for judgment on the basis of priority.  
(Paper 111 and Paper 119, respectively).<sup>1</sup> We deny the Howell motion and  
dismiss as moot the Lentz motion.

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<sup>1</sup> Oral argument was heard on 20 November 2007, before a court reporter. Mr. R. Danny Huntington, Esq., argued for Howell. Ms. Susan A. Cahoon, Esq. argued for Lentz.

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The subject matter of the count of the interference relates to a method of generating an immune response in an animal by filtering the blood to remove factors of the immune response. Previously, blood filtering strategies had been used to boost immune responses in cancer patients, but these strategies involved factors based on size alone. (See Howell involved patent 6,379,708 at col. 4, ll. 19-41; see also involved Lentz application 09/709,045 ('045) at col. 4, ll. 19-41; see also involved Lentz application 09/709,045 ('045) at col. 4, ll. 19-41; as a result, many different factors, and a large amount of blood serum, were removed from the blood. (See '708 patent at col. 4, l. 60, through col. 5, l. 12; see also involved Lentz application 09/709,045 ('045) at 6). To refine this treatment strategy, the parties propose removing the blood for selective factors that inhibit immune responses from the blood. (See '708 patent at claims 1-44 and '045 application at claims 23-41). One of these inhibitors is called soluble Tumor Necrosis Factor Receptor (sTNFR).

## II. FINDINGS OF FACT

## Howell

1. The involved Howell patent, 6,379,708, was filed 20 November 1999, and issued 30 April 2002.
2. The named inventors of the involved '708 patent are Mark Douglas Howell, Cheryl Lynn Selinsky, and Leland Charles Leber.
3. The real parties-in-interest of the '708 patent are said to be CytoLogic, Inc. and Colorado State University Research Foundation. (Paper No. 9).

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11. Claim 23 of the '045 application of Lentz recites:

A method of enhancing an immune response in a patient having soluble cytokine receptor molecules in the blood which inhibit the immune response, the method comprising:

(a) obtaining whole blood from the patient;

(b) separating plasma from the blood;

(c) contacting the plasma with at least one cytokine receptor inhibitor selected from the group consisting of antibodies or antibody fragments binding to soluble cytokine receptor molecules, and cytokine molecules and epitopes thereof binding to soluble cytokine receptor molecules;

(d) removing soluble cytokine receptor molecules bound to the cytokine receptor inhibitor from the plasma; and

(e) returning the plasma from which the soluble cytokine receptor molecules have been removed to the patient.

12. Claim 1 of the '708 patent of Howell recites:

A method of stimulating an immune response in a mammal having a pathological condition, comprising:

a. obtaining whole blood from the mammal;

b. separating the whole blood into a cellular component and an acellular component or a fraction of the acellular component, wherein said acellular component or said fraction of the acellular component contains a targeted immune system inhibitor selected from the group consisting of soluble receptors for tumor necrosis factors  $\alpha$  and  $\beta$ , interleukin-1 receptor antagonist, soluble receptors for interferon-  $\gamma$ , soluble receptors for interleukin-1, and soluble receptors for interleukin-6;

c. contacting the acellular component or said fraction of the acellular component with a binding partner capable of specifically binding to said targeted immune system inhibitor;

d. removing the binding partner bound to said targeted immune system inhibitor from said acellular component or said fraction of said acellular component to produce an altered acellular component or altered fraction of the acellular component having a reduced amount of the targeted immune system inhibitor;

1  
2 e. combining the cellular component with the altered acellular component  
3 or altered fraction of the acellular component to produce altered whole  
4 blood; and

5  
6 f. administering the altered whole blood to the mammal.  
7

8 Howell's Priority Case

9 Conception

10 13. Howell alleges that it conceived of the invention by 5 January 1997  
11 (Howell Priority Motion, Paper 111 at 1).

12 14. Howell asserts that its conception culminated from the ideas in a  
13 Research Proposal prepared in 1994 ("the 1994 Research Proposal") (Exh.  
14 2074) and the results of laboratory experiments subsequently published in  
15 Selinsky et al., "Multifaceted inhibition of anti-tumor immune mechanisms by  
16 soluble tumour necrosis factor receptor type 1," *Immunol.*, vol. 94, pp. 88-93  
17 (1998) ("the Selinsky 1998 paper") (Exh. 2015). (Howell MF<sup>2</sup> 47) (Exh. 2078 at  
18 ¶ 36; Exh. 2073 at ¶¶ 6-25).

19 15. The 1994 Research Proposal, which Howell says is the first part of  
20 its conception, includes a first part dated 7 March 1994 (Exh. 2074 at 7) and a  
21 second part dated 19 April 1994 (Exh. 2074 at 1). (Howell MF 48) (Exh. 2078 at  
22 ¶ 17).

23 16. On 7 March 1994, Dr. Howell put forth the hypothesis "that the  
24 presence of sTNFR in tumor bearing animals is sufficient to allow the tumor to  
25 grow, where it otherwise would not." (Howell MF 52) (Exh. 2078 at ¶ 19; Exh.  
26 2074 at 11).

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<sup>2</sup> Material fact.

1           17.     The 7 March 1994 part of the 1994 Research Proposal explains  
2     “that experimental proof of this principle 1) will formally demonstrate the  
3     importance of sTNFR in tumor survival; 2) will confirm the suggestion that the  
4     removal of sTNFR is responsible for the clinical benefit associated with  
5     ultrapheresis; and, 3) will justify future development of specific immunosorbent  
6     methods for the removal of sTNFR from the serum of cancer patients.” (Howell  
7     MF 53) (Exh. 2078 at ¶ 20; Exh. 2074 at 11).

8           18.     Dr. Howell explained that this experimental proof, when obtained,  
9     would be considered to be “a prelude to the development of immunosorbant  
10    methods for the selective removal of sTNFr from the serum of cancer patients.”  
11    (Howell MF 61) (Exh. 2078 at ¶ 22; Exh. 2074 at 13).

12          19.     In the 19 April 1994 part of the 1994 Research Proposal outlines  
13    experiments (1) “to demonstrate that sTNFR enhances tumor survival,” (Howell  
14    MF 65) (Exh. 2078 at ¶ 24; Exh. 2074 at 2); (2) “to produce monoclonal  
15    antibodies to canine sTNFR,” (Howell MF 66) (Exh. 2078 at ¶ 24; Exh. 2074 at  
16    2); (3) “to develop sTNFR ELISA assays for early detection of canine cancer,”  
17    (Howell MF 67) (Exh. 2078 at ¶ 24; Exh. 2074 at 2-3); (4) “to develop and test  
18    immunosorbent methods for the selective removal of sTNFR from sera or  
19    ultrafiltrates obtained from tumor-bearing dogs,” (Howell MF 68) (Exh. 2078 at  
20    ¶ 24; Exh. 2074 at 3); (5) “to evaluate the therapeutic benefit of ultrafiltration in  
21    canine oncology,” (Howell MF 69) (Exh. 2078 at ¶ 24; Exh. 2074 at 3-4); and (6)  
22    “to evaluate the therapeutic benefit of the combined immunosorbent/ultrafiltration  
23    method in canine oncology.” (Howell MF 70) (Exh. 2078 at ¶ 24; Exh. 2074 at 4).

1           20.     According to Dr. Howell, the experiments shown in the 1998  
2 Selinsky paper show that “sTNFR, and sTNFR alone inhibits the three cytotoxic  
3 mechanisms that are preeminent in anti-tumor immunity.” (Howell MF 102) (Exh.  
4 2078 at ¶ 36).

5           21.     From these findings, Howell reports Dr. Howell had “a reasonable  
6 belief that removing sTNFR, an inhibitor of TNF, would facilitate an immune  
7 response in the patient.” (Howell MF 103) (Exh. 2078 at ¶ 36).

8                                 Diligence

9           22.     The period during which Howell must show diligence begins no  
10 later than 21 May 1998, the day before Lentz reduced its invention to practice by  
11 filing of the '307 patent application. (Transcript of Oral Hearing, November 20,  
12 2007, Paper 151, at 27, ll. 9-18).<sup>3</sup>

13           23.     The period during which Howell must show diligence ends 20  
14 November 1999, the date Howell filed the involved underlying application for its  
15 involved patent.

16           24.     Howell provides a chart that sets out the activity performed by Dr.  
17 Selinsky during the critical period to show diligence. (Howell Priority Motion,  
18 Paper 111, at Appendix 3).

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<sup>3</sup> JUDGE TIERNEY: So for purposes of viewing Howell's motion, does it make any difference whether we use the April 1st date or the May 21st date?

MS. CAHOON: I don't think it ultimately does. There are huge gaps.

JUDGE TIERNEY: So for purposes of today, we could just give them the May 21st date and hear what they have to say and just simply --

MS. CAHOON: I think they would still fall woefully short if we did that, Your Honor....

1           25.     Howell asserts that during this critical period Dr. Selinsky was  
2     working to demonstrate that sTNFR1 protected tumors from immunological  
3     destruction, (Howell MF 125) (Exh. 2079 at ¶ 29) and to develop an  
4     immunosorbent matrix capable of specifically depleting sTNFR from plasma  
5     (Howell MF 126) (Exh. 2079 at ¶ 29).

6           26.     Dr. Selinsky's work during this period is said to be corroborated by  
7     Karen L. Boroughs (Exh. 2080) and Wayne A. Halsey, Jr. (Exh. 2083), who are  
8     said to have worked with Dr. Selinsky in the laboratory. (Howell MF 139).

9           27.     During this period Dr. Selinsky was said to have devoted seventy-  
10    one days, from 14 September 1998 to 23 November 1998, to the drafting of her  
11    doctoral dissertation. (Paper 111, Appendix 3 at 31-34).

12          28.     Howell did not argue, nor were we directed to testimony to show,  
13    that:

14          (1)     no one else could have performed work toward a reduction to  
15    practice during the time Dr. Selinsky was occupied with preparing her  
16    dissertation,

17          (2)     Dr. Selinsky was required to draft her doctoral dissertation at this  
18    particular time , or

19          (3)     this was a typical amount of time to spend drafting a doctoral  
20    dissertation

21          29.     During this period there were also numerous stretches of time of at  
22    least three days, not including weekends or holidays, in which no work towards  
23    reduction to practice was asserted by Howell, either in Appendix 3 to its Priority



1 Motion or in the Declaration of Cheryl Selinsky (Exh. 2079). These instances  
2 include, at least (not counting weekends and holidays):

3	<u>Dates</u>	<u>Length</u>
4	9 June 1998 – 11 June 1998	3 days
5	15 June 1998 – 19 June 1998	5 days
6	23 June 1998 – 26 June 1998	4 days
7	30 June 1998 – 8 July 1998	6 days
8	14 July 1998 – 17 July 1998	4 days
9	23 July 1998 – 27 July 1998	3 days
10	31 July 1998 – 6 August 1998	5 days
11	11 August 1998– 14 August 1998	4 days
12	19 August 1998 – 31 August 1998	9 days
13	24 November 1998 – 3 January 1999	26 days
14	5 January 1999 – 12 January 1999	6 days
15	7 February 1999 – 14 February 1999	5 days
16	18 February 1999 – 3 March 1999	10 days
17	5 March 1999 – 11 March 1999	5 days
18	15 April 1999 – 25 April 1999	7 days
19	2 June 1999 – 4 June 1999	3 days
20	13 July 1999 – 27 July 1999	11 days
21	12 October 1999 – 14 October 1999	3 days

22 30. In its Motion, Howell contends that Dr. Howell communicated a  
23 manuscript of the 1998 Selinsky paper to Dr. Lentz. (Motion at 16).

1           31.     Howell has not asserted that Lentz derived the invention claimed in  
2     the '045 application from Howell. (Paper 125 at 2; Transcript of Oral Hearing,  
3     November 20, 2007, Paper 151, at 37, ll. 4-8).

4           32.     Howell has not moved for judgment that the Lentz claims are  
5     unpatentable because of incorrect inventorship. (Paper 125 at 2; Transcript of  
6     Oral Hearing, November 20, 2007, Paper 151, at 38, ll. 11-13).

7           33.     At oral argument, counsel for Howell was unable to explain why  
8     communication of the Selinsky 1998 paper to Dr. Lentz would be relevant to  
9     determination of priority. (Transcript of Oral Hearing, November 20, 2007, Paper  
10    151, at 37, ll. 4-8-38, ll. 11-17).<sup>4</sup>

11           34.     III.    Legal Principles

12           Priority of invention goes to the first party to reduce an invention to  
13    practice unless the other party can show that it was the first to conceive the  
14    invention and that it exercised reasonable diligence in later reducing to practice  
15    that invention. *Cooper v. Goldfarb*, 154 F.3d 1321, 1327 (Fed. Cir. 1998).

16           The moving party bears the burden of proving (by a preponderance of the  
17    evidence) that it was prior to its opponent as to the subject matter of the count.

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<sup>4</sup>       JUDGE TORCZON: We don't have a derivation motion in front of us. We don't have a derivation motion to grant.

      MR. HUNTINGTON: Right. But the reason you don't have a derivation motion to grant is because derivation requires transmitting the entire invention to the other party. It's the Gambro case."

      "JUDGE TORCZON: ... We don't have the derivation in front of us. We don't have an inventorship motion in front of us.

      So even assuming that all these smoking guns exist, at this point the only thing we really need to know is, how does that change the priority case? I'm not hearing that.

      MR. HUNTINGTON: I don't know what else I can tell you."

1 37 CFR § 41.121(b). It follows that a party asserting diligence as part of its  
2 priority showing has the burden of showing that it acted with reasonable  
3 diligence.

4 The diligence requirement stems from the policy of encouraging inventors  
5 to disclose their inventions early. Thus, the first to file will prevail in a priority  
6 contest unless the first to conceive can show that it was diligent in filing its own  
7 application. See *Naber v. Cricchi*, 567 F.2d 382, 385, n.5 (CCPA 1977).

8 The party chargeable with diligence must account for the entire period  
9 during which diligence is required, or provide a compelling reason to excuse the  
10 failure to take action. *Griffith v. Kanamaru*, 816 F.2d 624, 626 (Fed. Cir. 1987).

11 An order has been issued in the interference requiring any party asserting  
12 diligence to provide a chart:

- 13 (1) listing all the days of the critical period,  
14 (2) stating what happened on *each day*, and  
15 (3) explaining every date gap in the diligence showing.  
16 (Standing Order (SO), Paper 2, at ¶ 208.6).

17 In considering whether or not a party engaged in reasonable diligence we  
18 use a “rule of reason” as determined in the particular circumstances of each  
19 case. *Litchfield v. Eigen*, 535 F.2d 72, 77 (CCPA 1976).

20 While gaps in the record of activity do not necessarily refute a showing of  
21 diligence, such gaps must be adequately explained. Compare *Litchfield* at 76-77  
22 (no diligence found because gap was said to be due to unexplained “budgetary  
23 limits”) with *Monsanto Co. v. Mycogen Plant Sci., Inc.*, 261 F.3d 1356, 1363-64

1 (Fed. Cir. 2001) (diligence found even though there were gaps of several months  
2 in laboratory records because explanation that ongoing activities, such as  
3 tending to growing plants, was provided).

4 “The correct inquiry is . . . whether it is reasonable for [a party asserting  
5 diligence] to require the public to wait for the innovation given the well settled  
6 policy in favor of early disclosure.” *Griffith*, 816 F.2d at 626. In *Griffith*, a  
7 professor’s three month delay in activity while he waited for more satisfactory  
8 funding and the arrival of a graduate student, was not determined to be  
9 excusable delay. The court noted that the university had “consciously chosen to  
10 assume the risk that priority in the invention might be lost to an outside inventor,  
11 yet, having chosen a noncommercial policy, [asked the court] to save it the  
12 property that would have inured to it if it had acted in single-minded pursuit of  
13 gain.” *Id.* at 628. The Court noted that waiting for graduate student did not justify  
14 the delay since there was no suggestion that the student was uniquely qualified  
15 to carry out the necessary experiments. *Id.* at 627.

### 16 III. Analysis

#### 17 A. Diligence

##### 18 1. Discussion

19 Howell alleges that it conceived an invention of the Count “by January 5,  
20 1997.” (Howell Motion at 1). Howell alleges that it then “earnestly pursued that  
21 invention until Howell constructively reduced the invention to practice when it  
22 disclosed the invention in [the application of the involved patent], filed November  
23 20, 1999.” (*Id.* at 1-2).

Howell cannot prevail on its motion unless it has shown that it acted diligently toward reducing to practice its invention during the critical period. In the present circumstances, we determine that the critical period begins no later than the day before the filing of Lentz's '307 application, i.e., 21 May 1998, and continues until Howell filed its involved application on 20 November 1999. (FF<sup>5</sup> 22-23).

At Appendix 3 of its Motion, Howell provides a chart which sets out the activity performed by Dr. Selinsky during the critical period. (FF 24). We have not been directed to activity performed by any other Howell inventor or anyone working at the direction of a Howell inventor. In evaluating Howell's diligence we have considered only the activities set out at Appendix 3. Moreover, we have not considered any activities, or gaps in activities, that occurred outside of the critical period.

The chart at Appendix 3 shows over 100 days<sup>6</sup> of unexplained gaps in activity during the critical period including the following:

<u>Dates</u>	<u>Length</u>
9 June 1998 – 11 June 1998	3 days
15 June 1998 – 19 June 1998	5 days
23 June 1998 – 26 June 1998	4 days
30 June 1998 – 8 July 1998	6 days
14 July 1998 – 17 July 1998	4 days

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<sup>5</sup> Finding of fact.

<sup>6</sup> This number does not include weekends or holidays. We also have not included gaps of less than 3 days in length.

1	23 July 1998 – 27 July 1998	3 days
2	31 July 1998 – 6 August 1998	5 days
3	11 August 1998– 14 August 1998	4 days
4	19 August 1998 – 31 August 1998	9 days
5	24 November 1998 – 3 January 1999	26 days <sup>7</sup>
6	5 January 1999 – 12 January 1999	6 days
7	7 February 1999 – 14 February 1999	5 days
8	18 February 1999 – 3 March 1999	10 days
9	5 March 1999 – 11 March 1999	5 days
10	15 April 1999 – 25 April 1999	7 days
11	2 June 1999 – 4 June 1999	3 days
12	13 July 1999 – 27 July 1999	11 days
13	12 October 1999 – 14 October 1999	3 days
14	In summary we have a delay in disclosure of over 100 days for which	
15	Howell, who has the burden of proof to show diligence, has provided no	
16	explanation. While perhaps there could be some reasonable explanation for the	

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<sup>7</sup> During oral argument Howell offered that the inactivity was due to vacation by Dr. Selinsky. (Transcript of Oral Hearing, November 20, 2007, Paper 151, at 33, ll. 12-15 (“This is a woman who had been working for five years doing research getting her Ph.D. The time period in November up until the beginning of January was a vacation and a well-deserved one. So it may not be on the chart, but it is in evidence here.”)). We do not see where Howell made such an argument in its Motion or where Dr. Selinsky testified concerning such a vacation. Instead, in its Motion, Howell acknowledges only one gap during the critical period, i.e., the time when Dr. Selinsky is said to have been working on her doctoral dissertation.

We do not consider Howell’s remarks at hearing to be part of its Motion and note that it would be prejudicial to Lentz for us to do so since Lentz has not had a chance to respond to the remarks or to cross-examine Dr. Selinsky about such a vacation.

1 gaps in activity, Howell has not provided such an explanation in its Motion  
2 (including the required diligence chart).<sup>8</sup> It is not our role to speculate as to what  
3 such an explanation may be, nor would it be fair to Lentz for us to do so. To the  
4 extent Howell has provided an explanation in its Reply, it has not been  
5 considered in evaluating whether Howell has carried its burden of setting forth a  
6 prima facie showing of diligence.<sup>9</sup>

7         The net effect of the gaps in activity is a sizable delay in Howell disclosing  
8 its invention to the public. While it may be that any one of the gaps, in isolation,  
9 might not be fatal to Howell's showing of diligence, it is the total effect of the gaps  
10 that is of concern. Was it reasonable for Howell to have required the public to  
11 wait for disclosure of the Howell invention? Howell, who is charged with the  
12 burden of proof on the issue, has not provided, in its Motion, any explanation of  
13 why the delay in disclosure is reasonable. Thus, on this record, we cannot  
14 determine that Howell acted with reasonable diligence.

15         In addition to the gaps for which Howell has provided no explanation,  
16 there is a gap of over two months (i.e., from 14 September 2007 to 23 November  
17 1998) during which Dr. Selinsky is said to have been working on drafting and  
18 preparing her Ph.D. dissertation. (FF 27).

19         Again, such a delay, in isolation, may not be fatal to Howell's showing of  
20 diligence. We must consider whether Howell has shown that it was reasonable

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<sup>8</sup> The Standing Order requires a diligence chart when a party alleges diligence. As noted: "Every date gap in the diligence showing must be explained." (See SO at ¶ 208.6).

<sup>9</sup> When a party, in its reply, directs us for the first time to evidence that is necessary to make out a party's prima facie case, that evidence will not be considered. (See SO at ¶122.5).

1 for it to delay public disclosure of the invention while Dr. Selinsky prepared and  
2 drafted her dissertation.

3 Howell argues that since Dr. Selinsky's preparation and drafting of her  
4 dissertation was an integral part of her livelihood, the delay it caused in reducing  
5 to practice the invention was excusable. Howell directs us to the decisions in  
6 *Courson v. O'Connor*, 227 F. 890 (7th Cir. 1915) and *De Wallace v. Scott*, 15  
7 App.D.C. 157 (D.C. Cir. 1899). We agree that an inventor need not abandon the  
8 inventor's usual job and livelihood to have been acting diligently. However,  
9 Howell has not directed us to evidence sufficient to establish that:

10 (1) Howell could not have directed others to work toward a reduction to  
11 practice during the time Dr. Selinsky was working on her dissertation. (For  
12 example, Howell did not direct us to evidence showing that no one else was  
13 available for, or capable of, continuing work toward a reduction to practice.).<sup>10</sup>

14 (2) Dr. Selinsky was required to complete her dissertation during the  
15 particular time she says she worked on it; ; or

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<sup>10</sup> Howell argued in its Reply that "the project was exclusively Selinsky's project (once she took it over from Boroughs and Halsey). All the graduate students in Dr. Howell's lab worked independently so that they would develop an ownership of their project and also so that they would have to master all of the methods necessary to bring the project to fruition." (Howell Priority Reply at Response to Lentz Fact 190). We do not consider this argument in reaching our decision on whether Howell has set forth a prima facie showing of diligence since the argument does not appear in Howell's Motion. Alternatively, even if we were to consider this argument, we would not find excusable delay. Howell made a conscious decision to continue the delay in disclosure so that Dr. Selinsky could have the benefit of performing the work on her own. Howell has not shown why delaying public disclosure for the benefit of Dr. Selinsky was being reasonably diligent.



1 (3) the amount of time Dr. Selinsky spent on her dissertation was  
2 reasonable under the circumstances

3 To the extent Howell has directed us to such evidence in its Reply, it has  
4 not been considered in evaluating whether Howell has carried its burden of  
5 setting forth a prima facie showing of diligence.<sup>11</sup>

6 Howell has not shown that it was reasonable to delay disclosure of the  
7 invention while Dr. Selinsky's prepared and drafted her dissertation. Howell has  
8 not shown why why no one else could have continued Dr. Selinsky's work , Dr.  
9 Selinsky had to delay her work toward a reduction to practice during the critical  
10 period, or why Dr. Selinsky had to spend over two months of the critical period on  
11 her dissertation.

12 Instead, it appears that Howell made a conscious decision that resulted in  
13 a further delay in the public disclosure of its invention. Such a decision carried  
14 with it the risk that priority of the invention might be lost to an outside inventor.

15 See *Griffith*, at 628.

16 2. Summary of diligence determination

17 The unexplained gaps combined with the gap due to Dr. Selinsky's  
18 preparation of her Ph.D. dissertation resulted in an over five month delay in  
19 disclosure of the Howell invention to the public. Howell has not directed us to  
20 evidence sufficient to show that such it was reasonable to delay disclosure for  
21 this length of time. Accordingly, we determine that Howell has not shown that it  
22 was reasonably diligent during the critical period.

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<sup>11</sup> See SO at.¶ 122.5.

1           Even if we were to determine that the gap in activity during the time Dr.  
2   Selinsky is said to have been working on her dissertation was "excusable," we  
3   would determine that Howell has not shown that it acted with reasonable  
4   diligence in reducing to practice its invention. Howell has provided no  
5   explanation as to numerous significant gaps in activity during the critical period.  
6   (FF 29). When we consider the unexplained gaps as a whole, we are not  
7   convinced that Howell has shown that it acted with the diligence that is required  
8   of an inventor seeking to obtain the patent protection that has been accorded to  
9   another.

10           B.     Communication to Lentz

11           In its Motion, Howell contends that Howell communicated a manuscript of  
12   the 1998 Selinsky paper to Lentz. (FF 30). Howell concedes that it is not  
13   alleging derivation by Lentz. (FF 31). Howell has not filed a motion seeking  
14   judgment against Lentz on the basis that the inventorship of the Lentz patent is  
15   incorrect. (FF 32).

16           At oral argument, Howell was unable to explain why communication of a  
17   partial conception is relevant to our priority determination. (FF 33).

18           Since Howell has not explained why its allegation that Howell  
19   communicated a "partial conception" to Lentz is relevant to the priority  
20   determination, we do not further consider Howell's arguments regarding  
21   communication of the manuscript.

V. Conclusion

We have determined that Howell has not shown reasonable diligence in reducing to practice its invention. Because Howell cannot prevail without a sufficient showing of diligence, we need not and do not reach a decision on Lentz's motion for judgment based on priority.

Since Howell did not set forth a prima facie showing of diligence in its Motion, we did not consider the Lentz Opposition or the Howell Reply.

VI. ORDER

Upon consideration of the record and for reasons given, it is

ORDERED that Howell's motion for judgment on the basis of priority is DENIED;

FURTHER ORDERED that Lentz's motion for judgment on the basis of priority is DISMISSED as moot; and

FURTHER ORDERED that judgment adverse to Howell shall be entered in a separate paper.

/Richard Torczon/  
Administrative Patent Judge

/Sally Gardner Lane/  
Administrative Patent Judge

/Michael P. Tierney/  
Administrative Patent Judge

)  
)  
)  
) BOARD OF  
) PATENT APPEALS  
) AND  
) INTERFERENCES  
)  
)  
)

Interference 105,413

cc (via electronic filing):

Interference 105,413

cc (via electronic filing):

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